



11/07/00

Art Unit: 1624

The request filed on 9/7/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/127059 is acceptable and a CPA has been established. An action on the CPA follows. Since no shift in invention has been indicated in the CPA request, the claims being examined are the same as in previous actions and thus claims 6-18 remain withdrawn.

Claims 1,2,4, and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The nature of hetero ring systems at B remains unclear. The phraseology does not exclude other hetero atoms as ring members. "Ring systems" is non-limiting as to number of rings permitted. How many rings can be fused together- 2,3,4? See Wiggins cited in previous actions. Its not even clear where the "carbon atom" can be- a ring carbon atom or a substituent on the ring.

Claims 1,2,4 and 5 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The newly amended B terminology lacks descriptive support for reasons given previously and in fact now **excludes** benzene fusion and thus the indolyl ring- the only ring system ever described in the original disclosure. In fact it reads literally on bi- and polyfused (never described for heteroaryl) 5- membered rings that are not even necessarily aromatic! Note that "unsaturated" is

Art Unit: 1624

not synonymous with aromatic, originally described. For the 6-membered ring note that the only mention of this comes in the discussion of fused aryls on p.5 and the only one example given (no genus) is benzodioxanyl while the new terminology cover a lot more.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Ward.

While the proviso (3) takes care of the generic claims, note that claim 21, 2nd species, remains an obvious variant for reasons given previously- see actions mailed 8/17/99 and 3/22/00.

Claims 1, 2, 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plilai and van der Stelt (US'256). Plilai teaches a similar compounds to that claimed as an antidepressant. See XII in table 1. While said compound no longer anticipates the claims, it is an obvious variant as it only differs in being unsubstituted in one of the phenyl rings vs. Instant Me (i.e. alkyl) substituted phenyl. H vs Me is not considered a patentable advance absent evidence of superior, unexpected results. Note In re Wood 199 USPQ 137; In re Lohr 137 USPQ 548; In re Fauque 121 USPQ 425. Thus it would have been obvious to one skilled in the art at the time the invention was made to expect compounds claimed herein that are methylated on the one of the phenyl rings to also possess the use taught by the art in view of the close structural similarity outlined above.

Art Unit: 1624

In responding to this expected rejection in the preliminary response applicants urge there is no teaching to replace H with Me in Plilai. Note that there was no such teaching in the case law applied above and yet claims were still refused based on the close structural similarity of H with methyl on carbon atoms. Applicants further urge methylated compounds of Plilai would not be enabled but this is not ageed with. Plilai relies on simple processes to make his amino compounds starting with an aldehyde (diphenylacrolein) which is employed to make intermediates such as (III) which go on to make the piperazine derivatives. The corresponding methylated analogs of diphenylacrolein are well known in the art and can be found in van der Stelt who employed both a para tolyl derivative as well as an orthotolyl. See the first two lines of eg.I and lines 45- to the end of eg.I as well as first 2 lines of eg.III.

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are

Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.

E. Bernhardt
EMILY BERNHARDT
PRIMARY EXAMINER